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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,216	12/29/1999	OLEG B. RASHKOVSKIY	INTL-0319-US	2005

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EXAMINER
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ART UNIT	PAPER NUMBER
2611	5

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/474,216	RASHKOVSKIY, OLEG B.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-59* is/are pending in the application.

4a) Of the above claim(s) *1-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 31 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6, which is dependent upon Claim 1, of copending Application No. 09/196,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/196,262 Claim 6 and Application No. 09/474,216 Claim 31 are both directed towards 'monitoring a video transmission'. The claimed 'monitoring one video transmission' of Application No. 09/474,216 Claim 31 equates to lines 3-4 of Application No. 09/196,262 Claim 1, upon which Claim 6 is dependent. The claimed 'generating a notification' of Application No 09/474,216 Claim 31 equates to lines 5-6 of Application No. 09/196,262 Claim 1, upon which Claim 6 is dependent. The claimed 'predetermined time associated with one video transmission' of Application No. 09/474,216 Claim 31 equates to lines 3-4 of Application No. 09/196,262 Claim 6.

Application No. 09/474,216 Claim 31 differs from Application No. 09/196,262 Claim 6 in the additional limitation of 'monitoring for a predetermined time associated with the one video transmission'. It would have been obvious to 'monitor for a predetermined time' in order to display the 'notification' of the time at the corresponding time. If the system is already generating a notification of a time occurring, it would have been obvious that monitoring for that time would have to take place.

2. Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 09/196,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because both Application No. 09/474,216 Claim 35 and Application No. 09/196,262 Claim 17 are both directed toward 'an article comprising a medium for storing instructions...(for) monitoring a video transmission'. The claimed 'monitoring one video transmission' of Application No. 09/474,216 Claim 31 equates to lines 3-4 of Application No. 09/196,262 Claim 17. The claimed 'generating a notification' of Application No 09/474,216 Claim 31 equates to lines 5-6 of Application No. 09/196,262 Claim 17.

Application No. 09/474,216 Claim 35 differs from Application No. 09/196,262 Claim 17 in the additional limitation of 'monitoring for a predetermined time associated with the one video transmission' and that the predetermined event is a predetermined time. It would have been obvious to monitor for a predetermined time so that a user could be notified of a specific time of a video transmission that he or she is interested in.

Furthermore, if the system is already generating a notification of a time occurring, it would have been obvious that monitoring for that time would have to take place.

3. Claim 42 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/196,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/196,262 Claim 1 and Application No. 09/474,216 Claim 42 are both directed towards 'monitoring a video transmission'. The claimed 'monitoring one video transmission' of Application No. 09/474,216 Claim 42 equates to lines 3-4 of Application No. 09/196,262 Claim 1. The claimed 'generating a notification' of Application No 09/474,216 Claim 42 equates to lines 5-6 of Application No. 09/196,262 Claim 1.

Application No. 09/474,216 Claim 42 differs from Application No. 09/196,262 Claim 1 in the additional limitation of generating the notification when a 'predetermined score is detected'. It would have been obvious to monitor for a predetermined score so that a user could be notified of a specific score of a game that would make that game interesting or important to watch.

4. Claim 45 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 09/196,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/196,262 Claim 17 and Application No. 09/474,216 Claim 45 are both directed towards 'an article comprising a medium for storing instructions...(for) monitoring a video transmission'. The claimed 'monitoring

one video transmission' of Application No. 09/474,216 Claim 45 equates to lines 3-4 of Application No. 09/196,262 Claim 17. The claimed 'generating a notification' of Application No 09/474,216 Claim 45 equates to lines 5-6 of Application No. 09/196,262 Claim 17.

Application No. 09/474,216 Claim 45 differs from Application No. 09/196,262 Claim 17 in the additional limitation of generating the notification when a 'predetermined score is detected'. It would have been obvious to monitor for a predetermined score so that a user could be notified of a specific score of a game that would make that game interesting or important to watch.

5. Claim 51 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 09/196,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 09/196,262 Claim 4 and Application No. 09/474,216 Claim 51 are both directed towards 'monitoring a video transmission'. The claimed 'monitoring one video transmission' of Application No. 09/474,216 Claim 51 equates to lines 3-4 of Application No. 09/196,262 Claim 1, upon which Claim 4 is dependent. The claimed 'providing a video segment ' of Application No 09/474,216 Claim 51 equates to lines 1-4 of Application No. 09/196,262 Claim 4.

Application No. 09/474,216 Claim 51 differs from Application No. 09/196,262 Claim 4 in the additional limitation of 'detecting the occurrence of an event '. It would have been obvious to detect the occurrence of the event in order for the system to provide the correct video segment, that the event corresponds to.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 31-59 directed to the same invention as that of claims 1-24 of commonly assigned Patent Application 09/196,262. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claims 31-59 directed to an invention not patentably distinct from claims 1-24 of commonly assigned Patent Application and 09/196,262.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned Patent Application 09/196,262, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned

at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 51-53 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by De Saint Marc.

Regarding Claim 51, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). Also, De Saint Marc shows detecting the occurrence of an event in the course of the one video transmission (col. 2 lines 10-21) and providing a

video segment from the video transmission for display in the course of the second video transmission (col. 8 lines 35-50, col. 9 lines 9-20, 30-52).

Regarding Claim 52, De Saint Marc shows providing a video segment of a portion of the video transmission proximate in time to the occurrence of the event (col. 3 lines 38-49, col. 7 lines 53-58, col. 8 lines 43-50, col. 9 lines 15-20).

Regarding Claim 53, De Saint Marc shows storing the video segment (col. 8 lines 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 31, 32, 35, 36, 39-50, and 54-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further view of Cragun et al.

Regarding Claim 31, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a notification when a predetermined event occurs during the one video transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). De Saint Marc fails to show monitoring for a predetermined time associated with the one video transmission. Cragun shows the ability to monitor multiple occurrences in a television broadcast by the use of a monitoring

profile (col. 8 lines 48-54, col. 6 lines 1-38, col. 7 lines 21-28, see figures 4A-E). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the monitoring of De Saint Marc with the profile scanning ability of Cragun in order to enhance to the amount of scanning options available to the user. Then the user would be able to be notified when a plurality of events occur. Furthermore, Official Notice is take that since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input a time in order to monitor for that time.

Regarding Claim 32, Cragun shows the ability to monitor multiple occurrences in a television broadcast by the use of a monitoring profile (col. 8 lines 48-54, col. 6 lines 1-38, col. 7 lines 21-28, see figures 4A-E). Furthermore, Official Notice is take that since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input a time in order to monitor for a set amount of time remaining in a program.

Regarding Claim 35, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a notification when a predetermined event occurs during the one video transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). De Saint Marc fails to show monitoring for a predetermined time associated with the one video transmission and an article comprising a medium storing instructions that execute a processor-based system. Cragun shows the ability to monitor multiple occurrences in a television broadcast by the use of a monitoring profile (col. 8 lines 48-54, col. 6 lines 1-38, col. 7 lines 21-28, see figures 4A-

E). Furthermore, Cragun shows that the system is controlled by a computer processing system (col. 4 lines 33-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the monitoring of De Saint Marc with the profile scanning ability of Cragun in order to enhance to the amount of scanning options available to the user. Then the user would be able to be notified when a plurality of events occur. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc so that the system was controlled by a computer process like Cragun to automate the functions in order to alleviate the need for human control. Furthermore, Official Notice is take that since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input a time in order to monitor for that time.

Regarding Claim 36, the limitations of the claim have been discussed with regards to Claim 32.

Regarding Claim 39, the limitations of the claim have been discussed with regards to Claim 35.

Regarding Claim 40, Cragun further shows that the system is a video receiver (col. 3 lines 45-60).

Regarding Claim 41, De Saint Marc further shows transmitting video (col. 2 lines 1-5).

Regarding Claim 42, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a

notification when a predetermined event occurs during the one video transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). De Saint Marc does shows the ability to generate a notification when a score happens on said one video transmission (col. 2 lines 10-21). De Saint Marc fails to show monitoring for a predetermined score. Cragun shows the ability to monitor multiple occurrences in a television broadcast by the use of a monitoring profile (col. 8 lines 48-54, col. 6 lines 1-38, col. 7 lines 21-28, see figures 4A-E). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the monitoring of De Saint Marc with the profile scanning ability of Cragun in order to enhance to the amount of scanning options available to the user. Then the user would be able to be notified when a plurality of events occur. Furthermore, Official Notice is take that since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input score in order to monitor for that score.

Regarding Claim 43, Cragun shows the ability to select different search parameters, which could include score (col. 6 lines 1-40, col. 7 lines 1-29).

Regarding Claim 44, De Saint Marc provides a visual-on screen notification (col. 2 lines 1-21).

Regarding Claim 45, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a notification when a predetermined event occurs during the one video transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). De Saint Marc does shows the ability to generate a notification when a score happens on said one video transmission (col. 2 lines

10-21). De Saint Marc fails to show monitoring for a predetermined score and an article comprising a medium storing instructions that execute a processor-based system. Cragun shows the ability to monitor multiple occurrences in a television broadcast by the use of a monitoring profile (col. 8 lines 48-54, col. 6 lines 1-38, col. 7 lines 21-28, see figures 4A-E). Furthermore, Cragun shows that the system is controlled by a computer processing system (col. 4 lines 33-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the monitoring of De Saint Marc with the profile scanning ability of Cragun in order to enhance to the amount of scanning options available to the user. Then the user would be able to be notified when a plurality of events occur. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc so that the system was controlled by a computer process like Cragun to automate the functions in order to alleviate the need for human control. Furthermore, Official Notice is take that since Cragun shows the ability to input any search option for scanning the video, it would have been obvious to one of ordinary skill in the art at the time the invention was made to input score in order to monitor for that score.

Regarding Claim 46, the limitations of the claim have been discussed with regards to Claim 43.

Regarding Claim 47, the limitations of the claim have been discussed with regards to Claim 44.

Regarding Claim 48, the limitations of the claim have been discussed with regards to Claim 45.

Regarding Claim 49, the limitations of the claim have been discussed with regards to Claim 40.

Regarding Claim 50, the limitations of the claim have been discussed with regards to Claim 41.

Regarding Claim 54, De Saint Marc shows monitoring one video transmission while a receiver is tuned to a second transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). Also, De Saint Marc shows detecting the occurrence of an event in the course of the one video transmission (col. 2 lines 10-21) and providing a video segment from the video transmission for display in the course of the second video transmission (col. 8 lines 35-50, col. 9 lines 9-20, 30-52). De Saint Marc fails to show an article comprising a medium storing instructions that execute a processor-based system. Cragun shows that the system is controlled by a computer processing system (col. 4 lines 33-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc so that the system was controlled by a computer process like Cragun to automate the functions in order to alleviate the need for human control.

Regarding Claim 55, the limitations of the claim have been discussed with regards to Claim 52.

Regarding Claim 56, the limitations of the claim have been discussed with regards to Claim 53.

Regarding Claim 57, the limitations of the claim have been discussed with regards to Claim 54.

Regarding Claim 58, the limitations of the claim have been discussed with regards to Claim 40.

Regarding Claim 59, the limitations of the claim have been discussed with regards to Claim 41.

2. Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further view of Cragun and Lajoie.

Regarding Claim 33, De Saint Marc and Cragun both fail to generate a notification at a given time interval. Lajoie shows updating and presenting a notification at a time interval (col. 8 lines 4-18 and 40-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of De Saint Marc and Cragun with the time interval notification of Lajoie in order to update the user about a specific program at a set amount of time.

Regarding Claim 37, the limitations of the claim have been discussed with regards to Claim 33.

3. Claims 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further of view of Cragun and Morrison.

Regarding Claim 34, Both De Saint Marc (col. 2 lines 1-9) and Cragun (col. 3 lines 6-9) show the ability to present a notification. Both De Saint Marc and Cragun fail to show knowing if a program will end in a certain amount of time. Morrison shows the ability to display start time, elapsed time, end time, and the time remaining in a program (col. 1 lines 15-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc and Cragun with the ability to

display the time remaining of a program in order to inform the viewer of relevant program information.

Regarding Claim 38, the limitations of the claim have been discussed with regards to Claim 34.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lawler et al. U.S. Patent No. 5,699,107 discloses a program reminder system.

Knudson et al U.S. Patent No. 6,536,041 discloses a program guide system with real-time data sources.

Morse et al. U.S. Patent No. 6,055,419 discloses a system and method for including origination time and update lifetime with updateable messages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher Nalevanko
AU 2611
703-305-8093

cn
June 1, 2003

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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